

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE T. PLATTETER,
JUDY C. BOSSO AND ROBERT S. WESTFALL

Appeal No. 2006-0621
Application No. 09/938,237

ON BRIEF

MAILED

MAR 29 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before KRASS, JERRY SMITH, and BARRETT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-21, which constitute all the claims pending in this application.

The disclosed invention pertains to a document processing system having a marking engine that marks a sheet, a resource that transfers the sheet to the marking engine or receives the sheet from the marking engine, and a control bus for interconnecting the marking engine and the resource. A

particular feature of the invention relates to the process for maintaining synchronization between a master clock associated with the marking engine and a slave clock associated with the resource.

Representative claim 1 is reproduced as follows:

1. A document processing system comprising:

a marking engine that marks a sheet to form at least a portion of a document, the marking engine including a controller, the controller including a master clock and logic for generating a discrete clock synchronization interrupt signal;

a resource that transfers the sheet to the marking engine or receives the sheet from the marking engine, the resource including a slave clock related to operational timing of the resource and circuitry for receiving and processing the discrete clock synchronization interrupt signal; and

a control bus, interconnecting the resource and the controller, for distributing the discrete clock synchronization interrupt signal.

The examiner relies on the following references:

Yamanaka et al. (Yamanaka)	4,807,259	Feb. 21, 1989
Cheung et al. (Cheung)	5,535,217	July 09, 1996
Miyawaki	5,995,771	Nov. 30, 1999
Lackman et al. (Lackman)	6,343,351	Jan. 29, 2002
		(filed Sep. 03, 1998)
Shimoda et al. (Shimoda)	6,675,249	Jan. 06, 2004
		(filed Dec. 27, 2000)
Einbinder et al. (Einbinder)	6,704,302	Mar. 09, 2004
		(filed Feb. 04, 1999)

The following rejections are on appeal before us:

1. Claims 1, 3, 6, 7, 10, 11 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Miyawaki in view of Yamanaka.

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2. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Miyawaki in view of Yamanaka and further in view of Shimoda.

3. Claims 4 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Miyawaki in view of Yamanaka and further in view of Lackman.

4. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Miyawaki in view of Yamanaka and further in view of Einbinder.

5. Claims 5, 9 and 13-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Miyawaki in view of Yamanaka and further in view of Cheung.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants'

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arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434,

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1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii) (2004)].

We note that appellants' brief raises questions regarding the propriety of the finality of the final rejection and whether the examiner properly communicated to appellants the findings in support of the various rejections. As noted by the examiner, however, these questions relate to petitionable matters and are not within our jurisdiction.

We consider first the rejection of claims 1, 3, 6, 7, 10, 11 and 21 based on Miyawaki and Yamanaka. The examiner essentially finds that Miyawaki discloses the claimed invention except for the details of the synchronization between the controller of the marking engine and the resource. The examiner cites Yamanaka as teaching this feature. The examiner finds that it would have been obvious to the artisan to incorporate the synchronization teachings of Yamanaka into the document processing system of Miyawaki [answer, page 9].

Appellants argue that the examiner has not properly established some suggestion or motivation to combine Miyawaki and Yamanaka. Specifically, appellants argue that Miyawaki has nothing to do with clock synchronization. They also argue that Yamanaka uses a serial communications channel rather than the discrete signal as claimed. Appellants argue that Yamanaka is

not directed to a document processing system and does not synchronize the operation of the CPU, typewriter or typewriter controller. Appellants also argue that the system bus of Miyawaki does not interconnect the resource and the controller as claimed. Finally, appellants argue that the examiner has failed to identify how the claimed invention reads on the applied prior art [brief, pages 12-21].

The examiner responds that the various modules of the Miyawaki document processing system "would require synchronization in order to operate properly." The examiner also asserts that appellants admitted that Yamanaka teaches synchronization between a master clock and slave clocks. The examiner reiterates that the artisan would have been motivated to synchronize the document processing system of Miyawaki with the synchronization taught by Yamanaka "for practical use [i.e., making successful copies]." Finally, the examiner asserts that the applied prior art teaches all the features of the claimed invention [answer, pages 14-22].

Appellants respond by reiterating their primary position that the examiner has failed to support his conclusory opinion that it would have been obvious to modify the processing system

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of Miyawaki with the teachings of Yamanaka. Appellants note that absent a proper motivation to combine the references, there is no prima facie case of obviousness [reply brief].

We will not sustain the examiner's rejection of claims 1, 3, 6, 7, 10, 11 and 21 because we agree with appellants that the record in this case fails to establish a prima facie case of obviousness. Although Miyawaki discloses a document processing system of the type recited in the claimed invention, Miyawaki fails to disclose how the various components, such as the marking engine and the resources, are interconnected. Miyawaki only vaguely teaches that serial communication units 16 communicate information with a document feeder, document finisher, and the like [column 4, lines 8-11]. There is no description whatsoever of the manner in which these elements are interconnected. There is also no description in Miyawaki of any synchronization between these elements. The examiner simply asserts that some general synchronization would be required for proper operation of the system. Thus, the concept of synchronization is totally lacking in Miyawaki, but the examiner asserts that synchronization would be necessary in Miyawaki. The examiner proposes to modify the synchronization of Miyawaki, which, as noted above, is not

disclosed by Miyawaki, with the synchronization taught by Yamanaka. Although the examiner asserts that Yamanaka teaches a document processing system because it includes a typewriter, it is readily apparent that Yamanaka fails to teach a document processing system of the type claimed or taught by Miyawaki. Yamanaka relates to synchronization of master stations and slave stations in power generating facilities, power transmission facilities or power substation facilities [column 1, lines 5-23]. Since Yamanaka is not directed to a document processing system as claimed or taught by Miyawaki, we fail to see how the synchronization for "practical use" in Yamanaka has anything to do with the document processing system of Miyawaki. We agree with appellants that the examiner's combination of Miyawaki and Yamanaka could only come from an improper attempt to reconstruct the claimed invention in hindsight.

Since the combination of Miyawaki and Yamanaka is relied on in support of all the rejections on appeal before us, we do not sustain the examiner's rejections of the claims with respect to any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-21 is reversed.

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REVERSED



ERROL A. KRASS)
Administrative Patent Judge)



JERRY SMITH)
Administrative Patent Judge)
BOARD OF PATENT
APPEALS
AND INTERFERENCES)



LEE E. BARRETT)
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